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EXAMINER

MCLEOD, MARSHALL M

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4152

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/806,836	Applicant(s) MANCHESTER ET AL.	
	Examiner Marshall McLeod	Art Unit 4152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-31 are pending in this application.
2. Claims 1-31 are presented for examination.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. With respect to claims 1-8 and 22-26, the claimed invention of computer readable medium is directed to non-statutory subject matter. In the specifications computer readable medium is said to comprise computer storage media and communication media (page 2 [0020] lines 6-7). In the specifications communication media is said to typically embody computer-readable instructions, data structures, program modules or other data in a modulated data signal such as a carrier wave or other transport mechanism and includes any information delivery media. The term "modulated data signal" as defined in the specifications means a signal that has one or more of its characteristics set or changed in such a manner as to encode information in the signal (page 2 [0020] lines 19-25). The specifications state that combinations of the any of the above are included within the scope of computer-readable media (page 2 [0020] lines 29-30).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined

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application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 9, 15, and 27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11, 1 and 17 of copending Application No. 10/806369. The subject matter in the instant application is fully disclosed in the copending application and is covered by the copending application as follows in Table 1 below.

Instant Application	Copending Application No. 10/806369
9. A portable media device for provisioning a computing device with network settings, the portable media device having stored thereon data comprising: an XML file containing network settings for setting up the computing device to join an ad hoc wireless network when the portable media device is connected to the computing device.	11. A portable computer-readable media device for provisioning an electronic device with network settings, the portable computer-readable media device having stored thereon data comprising: an XML file containing a network settings configuration for configuring the device to join a network; and an autorun file for prompting the device to automatically apply the network

<p>15. A method of provisioning a wireless computing device with network settings for joining an ad hoc wireless network, comprising:</p> <p>determining network settings for the ad hoc wireless network, the network settings including a network name and a network security key for the ad hoc wireless network; generating an Extensible Markup Language (XML) file including the network settings for the ad hoc wireless network; and writing the XML file to a portable media device, wherein the steps of determining, generating, and writing are performed on an initiating computer of the ad hoc wireless network.</p> <p>27. A method of configuring a computing device for joining an ad hoc wireless network, comprising:</p> <p>detecting installation of a portable media</p>	<p>settings configuration.</p> <p>1. A method of provisioning a network device with network settings, comprising:</p> <p>determining a network settings configuration for allowing the network device to join a network, wherein the network settings configuration includes at least a network name and a network encryption key;</p> <p>generating an Extensible Markup Language (XML) file including the network settings configuration; and writing the XML file to a portable computer-readable media device.</p> <p>17. A method of configuring a device for operation in a network, comprising:</p> <p>detecting the installation of a portable computer-readable media device; based on the</p>
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device on the computing device, the portable media device containing network settings for the ad hoc wireless network; and automatically configuring the computing device for joining the ad hoc wireless network using the network settings contained in the portable media device.	step of detecting, automatically uploading a configuration from the portable computer-readable media device, wherein the configuration includes network settings and device configuration information; applying the configuration automatically to the device; and joining the device to the network.
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Table 1.

7. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are claiming the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 27 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by King et al., US Publication Number 2002/0087868 A1, hereinafter King.

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10. With respect to claim 27, King discloses a method of configuring a device for operation in a ad hoc wireless (page 11 [158], lines 6-10) network (page 3 [0041], lines 6-11), comprising (page 2 [0011], lines 1-4):

a. detecting the installation of a portable media device on the computing device, the portable media device containing network settings for the ad hoc wireless network (pages 4-5 [0064], lines 1-11);

b. and automatically configuring the computing device for joining the ad hoc wireless network using the network settings contained in the portable media device (page 4-5 [0064], lines 1-11).

11. With respect to claim 29, King discloses the method of claim 27, further including the step of writing network settings configured on the computing device into the portable media device, (page 2 [0011], lines 1-4; page 12 claim 4; [0059]).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-5, 8-10, 13-19, 22-24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over King in views of Cedola, US Publication Number 2004/0221298 A 1, hereinafter Cedola.

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14. With respect to claim 1, King discloses a computer-readable medium having computer-executable instructions for performing steps for configuring wireless (page 11 [158], lines 6-10) devices for forming an ad hoc wireless network (page 2 [0011], lines 1-4), comprising: collecting network settings for the ad hoc wireless network, (page 6 [0084], lines 1-10). However, King does not disclose, prompting a user, through a user interface of an initiating computer, to create network settings for the ad hoc wireless network. On the other hand, Cedola discloses prompting a user, through a user interface of an initiating computer, to create network settings for the ad hoc wireless network, (page 4 [0039], lines 1-15).

It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the teachings of King with the teachings of Cedola. Because, King already discloses collecting network settings for the ad hoc wireless network, it would have been obvious and it is well known to a person having ordinary skill in the art that in order to collect network settings. A user would have to enter through a user interface of an initiating computer, the steps to create the network settings for the ad hoc wireless network.

King discloses generating a file including the network settings configuration (page 4 [0059]).

King also discloses writing the file to a portable computer readable media device (page 2 [0011], lines 1-4; page 12 claim 4). However, King does not disclose that the file is an XML file. On the other hand, Cedola discloses that the network configuration information is stored in XML format (Cedola, page 4 [0039]; page 1 [0016]).

It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the teachings of King with the teachings of Cedola. Because King discloses

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a network configuration file for reconfiguring a computer device, and Cedola suggests a network configuration could be stored in XML format (page 4 [0039], page 1 [0016])

A person with ordinary skill in the art would have been motivated to make the modification to King because having the network configuration file in XML format, would make it easier and simpler communicate between internal and external systems.

King discloses connecting the portable media device to a peer computing device for configuring the peer computing device for joining the ad hoc wireless network (Abstract). King however does not disclose instructing the user, through the user interface, to remove the portable media device from the initiating computer. On the other hand Cedola discloses instructing the user, through the user interface (page 5 [0052], lines 15-20). Even though both King and Cedola combined do not disclose instructing the user, through the user interface, to remove the portable media device from the initiating computer.

It would have been obvious to a person having ordinary skill in the art at the time of the invention to combine the teachings of King with the teachings of Cedola. To tell the user that once the connected the computer readable medium has stored the network configuration file. To remove the computer readable medium from the initiating computer and connect it to the computing device that want to configure (King, Abstract). Because without performing that step, the network configuration file the user stored on the computer readable medium would not be able to configure the new computing device with the network settings stored on the computer readable medium, which would still be connected to the initiating computer.

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15. With respect to claim 2, King as modified discloses wherein the step of collecting network settings includes generating, by the initiating computer, default values for selected network settings (Cedola, page 5 [0051], lines 1-6).

16. With respect to claim 3, King as modified discloses wherein the step of generating default values includes invoking an application program interface (API) of an operating system of the initiating computer to generate the default values for the selected network settings. (Cedola, page 4 [0039]).

17. With respect to claim 4, King as modified discloses wherein the step of collecting network settings includes generating a security key for the ad hoc wireless network (King, Abstract lines 11-15).

18. With respect to claim 5, King as modified discloses wherein the step of collecting network settings includes receiving network settings data entered by the user (King, page 4 [0057]; [0059]).

19. Claims 6, 7, 11, 12, 20, 21, 25, 26, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over King in view of Cedola and further in view of Polcha et al., US Publication Number 2003/0217126 A1, hereinafter Polcha.

20. With respect to claims 6, 11, 20, 25 and 30, King as modified discloses an invention as described in claims 6, 11, 20, 25 and 30. King does not disclose wherein the portable computer-readable media device is a USB flash drive. However, Polcha discloses the use of USB drive for network configuration (page 11 [0124], page 12 claim 7).

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have portable storage device of King to be the USB flash drive because King discloses

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where the portable storage device is hand holdable and hand insertable into and remove from the computer system, such as a SIM, or MEMORY STICK (page 4 [0058]), and King further discloses the computer system equipped with USB interfaces (page 11 [0150]), and Polcha suggests that the use of USB drive for network configuration. A person with ordinary skill in the art would have been motivated to make the modification to King because having the USB drive as the portable storage medium would allow hardware to be simply plugged in and automatically recognized (Plug and Play) while the computer is running as taught by Polcha.

21. With respect to claims 7, 12, 21, 26 and 31, King as modified discloses an invention as described in claims 7, 12, 21, 26 and 31, a computer-readable medium, wherein the portable media device is a flash memory card (King, page 4 [0057] [0058]).

22. With respect to claim 8, King as modified discloses a computer-readable medium as in claim 1, having further computer-executable instructions for performing steps of:

- a. detecting reconnection of the portable media device to the initiating computer (King, pages 4-5 [0064], lines 1-11); and
- b. retrieving by the initiating computer configuration data written by the peer computing device into the portable media device in connection with configuring the peer computing device for joining the ad hoc wireless network (Polcha, [0040] lines 1-4; King, page 2 [0011] lines 1-4; King, page 1 [0001]).

23. With respect to claim 9, King as modified discloses a portable media device for provisioning a computing device with network settings, the portable media device having stored thereon data comprising:

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- a. an XML file containing network settings for setting up the computing device to join an ad hoc wireless network when the portable media device is connected to the computing device (see rejection to claim 1).

22. With respect to claim 10, King as modified discloses wherein the data stored on the portable media device further include an autorun file for prompting the computing device to automatically apply the network settings configuration (King, pages 4-5 [0064]).

23. With respect to claim 13, King as modified discloses wherein the network settings include a network name and a network security key for the ad hoc wireless network (King, Abstract; page 2 [0011]; page 2 [0013]).

24. With respect to claim 14, King as modified discloses a network configuration application to be executed for configuring the computing device when the portable media device is connected to the computing device (King, page 2 [0011], lines 1-4; page 5 [0069], lines 1-9).

25. With respect to claim 15, King as modified discloses method of provisioning a wireless computing device with network settings for joining an ad hoc wireless network, comprising:

- a) determining network settings for the ad hoc wireless network, the network settings including a network name and a network security key for the ad hoc wireless network (King, Page 2 [0011], lines 1-4); and
- b) generating an Extensible Markup Language (XML) file including the network settings for the ad hoc wireless network (Cedola, page 4 [0039]; page 1 [0016]);
- c) writing the XML file to a portable media device, wherein the steps of determining, generating, and writing are performed on an initiating computer of the ad hoc wireless network (King, page 2 [0011], lines 1-4; page 12, claim 4).

26. With respect to claim 16, King as modified discloses connecting the portable media device to the computing device to be provisioned (King, page 2 [0011], lines 1-4); and executing a configuration program on the computing device to automatically configure the computing device using the network settings in the XML file on the portable media device (King, pages 4-5 [0064]).

27. With respect to claim 17, King as modified discloses wherein the step of determining includes generating by the initiating computer a network security key for the ad hoc wireless network (King, page 2 [0013], lines 1-3).

28. With respect to claim 18, King as modified discloses wherein the step of determining includes prompting a user to enter a network security key for the ad hoc wireless network (King, page 9 [0121], lines 1-8).

29. With respect to claim 19, King as modified discloses wherein the step of determining includes invoking an application program interface (API) of an operating system of the initiating computer to provide the network settings (Cedola, page 4 [0039]).

30. With respect to claim 22, King as modified discloses detecting installation of a portable media device on the computing device, the portable media device containing network settings for the ad hoc wireless network (King, pages 4-5 [0064], lines 1-11); and automatically configuring the computing device for joining the ad hoc wireless network using the network settings contained in the portable media device (Polcha, [0040] lines 1-4; King, page 2 [0011] lines 1-4; King, page 1 [0001]).

31. With respect to claim 23, King as modified discloses wherein the step of automatically configuring includes recognizing that the portable media device contains network settings, and

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invoking a configuration program to implement the network settings in the computing device (King, pages 4-5 [0064], lines 1-11).

32. With respect to claim 24, King as modified discloses having further computer- executable instructions for performing the step of writing network settings configured on the computing device into the portable media device (King, page 12, claim 18).

33. With respect to claim 28, King as modified discloses wherein the step of automatically configuring includes recognizing that the portable media device contains network settings, and invoking a configuration program to implement the network settings in the computing device (King, pages 4-5 [0064], lines 1-11).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marshall McLeod whose telephone number is (571) 270-3808. The examiner can normally be reached on Monday - Friday 7:30 a.m-5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nabil El-Hady can be reached on (571) 272-3963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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